



CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8)

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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being submitted by First Class mail to the US Patent and Trademark Office: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 or transmitted by facsimile to the U.S. Patent and Trademark Office, Fax No. (703)872-9306.

Date: 3/17/05

By: Patti Hespell  
Patti Hespell

Mail Stop Amendment

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In Re: Patent Application of Charles A. Eldering**

Conf. No.: 5900 : Group Art Unit: 2161  
Appln. No.: 09/807,887 : Examiner: Santos, Patrick JD  
Filing Date: April 19, 2001 : Att'y. Docket No.: T706-11  
Title: Consumer Profiling and Advertisement Selection System

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**INFORMATION DISCLOSURE STATEMENT**

Each of the documents listed on the attached Information Disclosure Statement Citation Form PTO/SB/08A may be material to the patentability of the above-identified patent application and/or may result in a duty to disclose in accordance with 37 C.F.R. §1.56.

In accordance with the official waiver posted July 11, 2003, copies of the U.S. Patents and U.S. Patent Publications listed on the attached Form PTO/SB/08A are not being provided. However, copies of the foreign references and non-patent documents are enclosed. The official waiver withdraws the requirement under 37 C.F.R. § 1.98(a)(2)(i) for submitting copies of each listed U.S. Patent and U.S. Patent Application Publication with respect to applications filed after June 30, 2003. Copies of the listed U.S. Patent documents will be provided upon request.

The filing of this Information Disclosure Statement shall not be construed as an admission that any of the listed documents constitute prior art, nor as an admission against interest in any manner.

Application No. 09/807,887

This Information Disclosure Statement is being submitted:

- ☒ (1) within three (3) months of the filing date, entry into national phase in an international application or before the mailing date of the First Office Action; or
- ☐ (2) after the period defined in (1) above but before the mailing date of a Final Rejection or Notice of Allowance, and
- ☐ Certification is made below, or
- ☐ The check or authorization to charge Deposit Account No. \_\_\_\_\_, in the amount of the fee set forth by 37 C.F.R. §1.17(p) is attached.
- ☐ (3) after the mailing date of a Final Rejection or Notice of Allowance but before the payment of the Issue Fee, and
- ☐ Applicant hereby Petitions the Commissioner to consider the attached references; Certification is made below and the fee is included.

It is respectfully requested that this Information Disclosure Statement and the documents listed on the attached Form PTO/SB/08A and SB/08B be considered and acknowledged by the Examiner in connection with the above-identified patent application, be made of record therein, and that the listed document(s) be cited in the issued patent.

Respectfully submitted,

Charles A. Eldering  
 Charles A. Eldering  
 Reg. No. 39,180  
 Technology, Patents and Licensing Inc.  
 6206 Kellers Church Road  
 Pipersville, PA 18947  
 (215) 766-2100

Date: March 17, 2005



PTO/SB/08A (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

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Substitute for form 1449/PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Sheet 1 of 2**Complete if Known**

Application Number	09/807,887
Filing Date	19 APR 2001
First Named Inventor	ELDERING
Art Unit	2171
Examiner Name	SANTOS, PATRICK JD
Attorney Docket Number	T706-11

**U. S. PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)			
	AAB	US- 4930011	05/29/1990	Kiewit; David A.	
	AAC	US- 5099319	03/24/1992	Esch; Arthur G.	
	AAD	US- 5758257	05/26/1998	Herz; Frederick et al	
	AAE	US- 5918014	06/29/1999	Robinson; Gary B.	
	AAF	US- 5930764	07/27/1999	Melchione, Anthony T.	
	AAG	US- 6009409	12/28/1999	Adler; Micah A.	
	AAH	US- 6084628	07/04/2000	Sawyer; Francois	
	AAI	US- 20030088872	05/08/2003	Maissel, Jonathan et al	
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**FOREIGN PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)				
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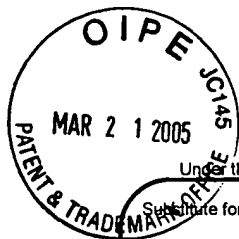
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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(Use as many sheets as necessary)

**Complete if Known**

Application Number	09/807,887
Filing Date	19 APRIL 2001
First Named Inventor	ELDERING, CHARLES A.
Art Unit	2161
Examiner Name	SANTOS, PATRICK JD
Attorney Docket Number	T706-11

Sheet	2	of	2
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**NON PATENT LITERATURE DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	CJ	ARMSTRONG, LARRY, "Coupon Clippers, Save Your Scissors", Business Week, June 20, 1994, pgs. cover, table of contents, 164, 166.	
	CK	ROSSI, MCCULLOCH, ALLENBY, "The Value of Purchase History Data in Target Marketing", Marketing Science; Vol. 15, No. 4, 1996, 20 pgs.	

Examiner Signature		Date Considered	
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.

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Filing Date: April 19, 2001 : Att'y. Docket No.: T706-11

Title: Consumer Profiling and Advertisement Selection System

COMMUNICATION

The attached materials are being submitted in the interest of full disclosure and to satisfy Applicants' duty of candor to the U.S. Patent & Trademark Office under 37 C.F.R. 1.56 in connection with the above-identified patent application. The attached materials are not believed to bear on the patentability of any of the pending claims of the present application. The attached materials reflect positions asserted by a third party (Catalina Marketing Corp.) in a litigation involving U.S. Patent Nos. 6,216,129, parent to the present application, ("the '129 patent") and 6,298,348 ("the '348 patent"). Applicants disputed the positions taken by Catalina during the litigation. No ruling was ever made by any Court with respect to the motions included in the attached materials, and the litigation has since been settled.

The attached materials include the following:

1. Defendant's Motion for Summary Judgment of Invalidity of the '129 and '348 Patents.
2. Defendant's Brief in Support of Its Motion for Summary Judgment of Invalidity of the '129 and '348 Patents.
3. Declaration of John V. Gorman in Support of Defendant's Motion for Summary Judgment.
4. Plaintiff Expanse Networks, Inc.'s Brief in Opposition of Defendant's Motion for Summary Judgment of Invalidity of the '129 and '348 Patents.
5. Defendant's Reply in Support of Its Motion for Summary Judgment of Invalidity of the '129 and '348 Patent.
6. Second Declaration of John V. Gorman in Support of Defendant's Motion for Summary Judgment.

Respectfully submitted,

Date: March 17, 2005

By: Charles A. Eldering

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